REMARKS

I. Status of the Application

Claims 24 and 26-39 are pending in this application. In the January 15, 2009 final office action, the Examiner rejected claims 24, 26-34 and 37-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over US 5,917,355 to Klass in view of applicant's admitted prior art.

In this response, applicant has cancelled dependent claim 26 and incorporated the limitations of cancelled claim 26 into independent claim 27, along with clarifying limitations. Applicant respectfully requests reconsideration of claims 24 and 27-39 in view of the foregoing amendments and the following remarks.

II. The Examiner's Final Rejection of Claim 27, 35 and 36 is Improper

In the January 15, 2009 Office action, the Examiner finally rejected claims 27, 35 and 36. However, it is respectfully submitted that at least the final rejection of claims 27, 35 and 36 is improper.

A. The Examiner has Introduced New Grounds of Rejection

As set forth in MPEP § 706.07(a) a "second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection* that is [not] necessitated by applicant's amendment of the claims" (emphasis added). Furthermore, as also set forth in MPEP § 706.07, "In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and … *clearly developed to such an extent that applicant may readily judge the advisability of an appeal*." Additionally, "The examiner

should never lose sight of the fact that *in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and the examiner should be developed*". MPEP § 706.07 (emphasis added).

In the January 15, 2009 final office action, the examiner finally rejected independent claims 27, 35 and 36, which had not been amended in applicant's previous response of October 20, 2008. However, in responding to the applicant's arguments in the October 20, 2008 response, the examiner's final office action cites a new reference as providing "the motivation to combine" certain limitations from the cited references. In particular, at page 2 of the final office action, the examiner cites U.S. Patent No. 4,737,735 to Kampes (hereinafter "*Kampes*") as providing "the motivation to combine said capacitor with said master latch". However, this is the first time this reference has been provided by the examiner as providing a motivation to combine. Accordingly, the final rejection of January 15, 2009 includes a new ground of rejection (in the form of a new motivation to combine) that was not necessitated by applicant's amendments to the claims. This is in direct contradiction to MPEP § 706.07(a) which requires a new ground of rejection to be necessitated by applicant's amendment in order for the rejection to be final. Accordingly, for at least this reason, the examiner's final rejection of claims 27, 35 and 36 is improper and should be withdrawn.

B. The Examiner Has Not Addressed Applicant's Arguments

In addition to the above, even if the examiner argues that the rejection of claim 27 is not on "new grounds", it is respectfully submitted that the examiner has refused to address the arguments made with respect to claim 27 in applicant's October 20, 2008 response. As required under MPEP § 706.07, "The examiner should never lose sight of the fact that in

every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and the examiner should be developed". In the present case, a "clear issue between applicant and the examiner" has not been developed as required under MPEP § 706.07, as the examiner has not addressed all of the issues raised in the October 20, 2008 response to office action.

One example of an issue raised in applicant's October 20, 2008 response is whether "connecting a capacitor to an output node of a signal level displacement would be generally accepted as an obvious measure used to filter noise" (see p. 9, lines 1-3 of applicant's October 20, 2009 response). As argued by applicant in the October 20, 2008 response,

> there is no reason to filter noise in connection with a signal level displacement of a *flip flop*, and the examiner has not suggested a reason for doing so. Even if one were to assume that a person skilled in the art would use a capacitor connected to ground as a filter, *there is no reason to combine the concept of a noise filter with a signal level displacement circuit for a flip flop*. (emphasis added)

The examiner completely failed to address this argument in the January 15, 2009 final office action. Instead, the examiner cited the new Kampes reference as allegedly providing a motivation to combine a capacitor with a master latch to reduce noise. However, even with the newly cited reference, applicant's argument that, "even if one were to assume that a person skilled in the art would use a capacitor connected to ground as a filter, *there is no reason to combine the concept of a noise filter with a signal level displacement circuit for a flip flop*," has not been refuted by the examiner.

In view of the foregoing, it is respectfully submitted that the examiner's final rejection of claim 27 is improper. In particular, the examiner can not cite new art against applicant's

unamended claim and then finally reject the claim. Furthermore, the examiner can not refuse to address applicant's arguments related to an unamended claim and then finally reject that same unamended claim. Based on the examiner's actions, it is impossible for applicant to determine whether an appeal is in order, as "a clear issue has not been developed between the examiner and the applicant." Accordingly, it is respectfully requested that the examiner should withdraw the current final rejection of claim 27 and should provide a new non-final office action that clearly sets forth the grounds of rejection of claim 27.

III. The Rejection of Claim 27 Under 35 U.S.C. § 103(a) Should be Withdrawn

In the January 15, 2009 office action, the Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Klass in view of applicant's admitted prior art (AAPA). In this response, Applicant respectfully traverses the Examiner's rejection of claim 27 under 35 U.S.C. § 103(a).

In order to establish a *prima facie* case of obviousness, three basic criteria should be met as set forth in MPEP § 2143.01-2143.03. First, all claim limitations must be considered. MPEP § 2143.03. Second, there must be some suggestion or motivation to modify the references or combine reference teachings. MPEP § 2143.01. Third, there must be a reasonable expectation of success. MPEP § 2143.02. In this case, it is respectfully submitted that the examiner has failed to make a prima facie case of obviousness with respect to amended claim 27 for at least the reason that all claim limitations are not taught or suggested by the cited references.

A. The Cited References Do Not Teach of Suggest All Claim Limitations

In the present case, it is respectfully submitted that neither Klass nor Fig. 4 of the present application ("AAPA") teach or suggest all the limitations of amended claim 27. One example of a limitation of claim 27 that is not taught or suggested by the cited references is that of a signal level displacement circuit comprising "a slave latch circuit … [and a] first isolating circuit and [a] second isolating circuit [that] are located outside the slave latch circuit" (emphasis added).

In the Final Office action of January 15, 2009, the examiner suggests that AAPA (i.e., Fig. 4 of the present application) and Klass together show all the limitations of claim 27. In particular, the examiner appears to interpret the transmission gate TG of Fig. 4 as a first isolating circuit. The examiner also appears to interpret the clocked inverter within the slave latch of Fig. 4 as a second isolating circuit. Thus, according to the examiner's interpretation, the *slave latch* of FIG. 4 (AAPA) actually *includes* the second isolating circuit (i.e. the clocked inverter). However, amended claim 27 clearly states that the first and second isolating circuits "are located *outside* the slave latch circuit". Thus, AAPA simply does not disclose the limitation of amended claim 27 of a signal level displacement circuit comprising "a slave latch circuit … [and a] first isolating circuit and [a] second isolating circuit are located *outside* the slave latch circuit" (emphasis added). Accordingly, even if the references were combined as suggested by the examiner, the combination of the references would not arrive at the claimed limitation.

B. The Examiner's Official Notice Has Been Challenged and Should be Withdrawn

At page 5 of the January 15, 2009 Final Office action, the examiner took "official notice that it is notoriously old and well known that a capacitor connected to ground at an output to *any* circuit serves as a filter." The examiner then concludes that "it would have been obvious to one of ordinary skill in the art at the time of the invention to include a capacitor directly connected between ground and node X of Klass's invention in order to filter noise." Applicant respectfully traverses this official notice and conclusion made by the examiner.

As set forth in MPEP § 2144.03, "official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances." "While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection." MPEP § 2144.03. Furthermore, it "is not appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known." MPEP § 2144.03

In the present case, applicant respectfully traverses the examiner's suggestion that connecting a capacitor to an output node of *any circuit,* and specifically a signal level displacement circuit, would be generally accepted as an obvious measure used to filter noise. In particular, there is no reason to filter noise in connection with a signal level displacement circuit for a flip flop, and the examiner has not provided any reference or suggested a reason for doing so. Even if it is assumed that a person skilled in the art would use a capacitor connected to ground as a filter for *some* circuits, there is no reason to combine the concept of a noise filter with *all* circuits, and specifically a signal level displacement circuit for a flip

flop. Indeed, the examiner has not shown any prior art that would suggest a reason to combine the concept of a noise filter with a signal level displacement circuit for a flip flop as is required under MPEP § 2144.03. Accordingly, it is respectfully submitted that the examiner's official notice is improper and should be withdrawn.

IV. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,

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